

B) REMARKS

The Examiner issued a restriction requirement on the grounds that claims 1 through 11, drawn to a *method* of increasing the efficiency by which *images* of consumer products are delivered to web pages on the internet, are patentably distinct from claims 12 through 14, which are drawn to a *server system* used to deliver *images* to internet websites.

A process and apparatus for use in practicing the process can be shown to be distinct by either of the following: (a) that the process *as claimed* can be practiced by a materially different apparatus or by hand; (b) that the apparatus *as claimed* can be used to practice another and materially different process. MPEP § 806.05(e)(emphasis in original). It appears as if the Examiner has restricted the present claims under the second prong of the inquiry.¹

The applicant respectfully submits, that *as claimed*, claims 12 through 14 could never be practiced as the Examiner suggests, "in inventory management (itemization of parts, supplies, or services e.g., bill of materials), or in inventory monitoring" because, claim 12, *on its face*, is limited to *images* being stored on a file server. Therefore, the claimed apparatus could never be used for "itemization of parts, supplies or services."

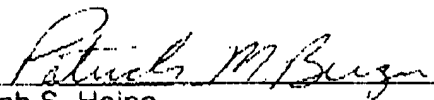
Moreover, restriction is normally precluded when the claims are not patentable over each other. *In re Kelly*, 200 USPQ 560 (Comm'r Pat. & Tm. 1978). The nullification of double patenting as a grounds of rejection imposes a heavy burden on the Examiner to guard against erroneous requirements for restriction where the claims define essentially the same invention and, which, if acquiesced in, will result in more

¹ It is acknowledged by the applicant that the Office requires only one-way distinctiveness as to process or apparatus and products made.

than one patent for essentially the same invention. *In re Herrick*, 115 USPQ 412 (Comm'r Pat. 1957). It is respectfully submitted that either set of claims in the instant application (i.e. claims 1-11 or claims 12-14) would preclude the other set from being patented or could result in double patenting of the same invention.

The applicant has provided a new, useful and nonobvious method and system for increasing the efficiency with which images of consumer products are provided to consumers via the internet and has drawn the claims specifically to that invention. Therefore, the applicant respectfully requests that the Examiner withdraw the restriction requirement such that prosecution of the application can move forward.

Respectfully submitted,
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